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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,808	02/11/2002	Brian T. Holland	CM-103A US	4382

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EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 05/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,808

Applicant(s)

HOLLAND ET AL.

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 21-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

1. This application contains claims 18-20 drawn to an invention nonelected without traverse in Paper No. 06. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "in an amount effective" in claim 22 is a relative term, which renders the claim indefinite. The term "in an amount effective" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what range or amount of dispersant in the composition is claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8, 11-17, 21 and 22 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by George et al.

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George et al. discloses all the limitations of claims 1, 12 and 21, i.e., a composition comprising organic acid, a metal oxide (color enhancer/hardeners), and a plasticizer, e.g., linear alcohol or secondary alcohol, wherein the organic acid is about 1 to 50 weight percent (claim 3); metal oxide is about 1-50 (col. 3, last line) and the "plasticizer" is about 0 to 5 percent (claim 7).

Regarding claims 2-8, 10, 11 and 13-17, George et al. meets the limitations, e.g., dispersant, thickener (col. 3, lines 49-53 and col. 5, lines 20-37); water and wherein the composition is used to buff a stone surface.

Regarding claim 22, George et al. meets the claim limitations as best understood.

6. Claims 21, 22 (as best understood) and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wirth et al.

Wirth et al. discloses all the limitations of claims 21-24, i.e., a composition comprising organic acid (col. 6, line 35), a metal oxide (col. 18, line 65), a dispersant (col. 4, line 36) and phosphate derivative plasticizer (col. 17, lines 23-26).

Regarding claim 22, Wirth et al. meets the claim limitations as best understood.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 10, 22 (as best understood) and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al.

George et al. discloses all the limitations of the above claims, except for the size of the metal oxides and amount of "dispersant" present. It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to use the specific sizes recited, e.g., 100 nanometer, depending on the workpiece and/or operational parameters, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

9. Claims 22 (as best understood) and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wirth et al.

Wirth et al. discloses all the limitations of the above claim, except for the size of the metal oxides and amount of "dispersant" present. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the specific sizes recited, e.g., 100 nanometer, depending on the workpiece and/or operational parameters, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

11. Applicant's arguments filed March 03, 2004 have been fully considered but they are not persuasive. The argument that George, et al. uses "surfactant" and not a "plasticizer" is not persuasive, since the terms as broadly recited in the claims are only defined by the elements defining the terms, i.e., "plasticizer" is only defined by the further dependent claim 11, as being primary and secondary alcohols, and as such George et al. meets the limitations, i.e., a composition comprising primary and secondary alcohols, and whether these elements are intended to be used as surfactant, plasticizer, etc, are irrelevant so long as the elements recited in the composition are met. The argument that formulations of George et al. are considered different from the surface restoration composition of the present invention and/or it uses a two stage process, are not persuasive since it fails to point out what recited limitation of the composition is not met. The argument that one of ordinary skill in the art would readily understand that a plasticizer is used to improve flow and therefore processability, is not persuasive, since functional and/or narrative language fails to further limit the composition, a composition having primary and secondary alcohols as the narrowest claim (regarding "plasticizer"), is met by George et al. The arguments regarding "thickener", "dispersants" are not persuasive for the same reasons as stated above. And whether George et al. uses an organic solvent to increase the evaporation rate or not is irrelevant since again it fails to point out what recited element is not met. The argument regarding the USC 103(a) rejection that in George et al. the modification to the size of the metal oxide would be regarding the color enhancement and hardeners and not for the purpose of acting as filler for the damaged surface, is not persuasive, since the intended use does not exclude the reference for meeting the claimed invention as

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recited, i.e., George et al. modified to include metal oxides having a size of between 1 nm to 100 micron, for purposes other than acting as filler, would still meet the recited limitations.

George et al. meets the present invention as recited.

Conclusion

12. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Richardson et al. is cited to show related inventions.

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279 for unofficial documents. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 6:00 PM. All official documents may be faxed to (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1148.



Hadi Shakeri
Patent Examiner
May 8, 2004